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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,957	02/26/2002	Jeffrey H. Nycz	DEP610	5011

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EXAMINER

RAMANA, ANURADHA

ART UNIT PAPER NUMBER

3732

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,957

Applicant(s)

NYCZ ET AL.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-20 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 10-20 drawn to an acetabular cup and a method of its use, classified in class 623, subclass 22.36.
- II. Claims 8 and 9, drawn to a punch tool, classified in class 30, subclass 363.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the tool can be used for making holes in a layer by removing material from the layer by punching the layer. The subcombination has separate utility such as hip socket replacement.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with John S. Wagley on 3/6/03 a provisional election was made to prosecute the invention of I, claims 1-7 and 10-20. Affirmation of this election must be made by applicant in replying to this Office action. The applicant must also indicate clearly whether the election is with or without traverse. Claims 8 and 9 are withdrawn from

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further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference element mentioned in the description: porous coating 76 (page 12, para 1, line 6) is not shown in the drawings. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities. On page 9, para 5, line 4: liner "40" must be liner "30" to consistent with the drawings and the disclosure.

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities. In line 1, "A" should be "An" to correct a minor typographical error.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6, 7, 10, 11, 13, 14, 15, 18, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (US 5,370,702).

Regarding claims 1, 4, 6, 10, 13, 15 and 19, Jones discloses an implant or prosthesis or cup 10 having a wall 16 with one or more removable portions or sections 24 of reduced thickness. Jones further discloses that the thin sections 24 may be about 0.005 inches thick and that punching may be applied to remove base 26 of the thin section 24 to form a hole in cup 10; the hole being used to fasten cup 10 by a bone screw or other fastener (col. 1, lines 7-10; col. 2, lines 14-38 and line 68; col. 3, lines 1-3, lines 13-19, lines 22-23, lines 37-49 and lines 57-64; col. 4, lines 15-18, lines 35-37 and lines 43-47; and Figures 1 and 3).

Regarding claims 2 and 11, in regard to the reduced thickness portion being “adapted to block the flow of synovial fluid therethrough,” it has been held that the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding claim 7, 14 and 18, in regard to the reduced thickness portion being “adapted to be sheared by a punch tool,” it has been held that the recitation that an element is adapted to perform a function is not a positive limitation but only requires the ability to so perform and does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

The method steps of claim 20 are inherently performed during normal use of the prosthesis or cup 10 of Jones for the purpose of replacement of the acetabulum or hip socket due to bone disease or severe fracture (col. 1, lines 13-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones.

Regarding claims 3, 12 and 16, Jones does not specifically disclose that removable portion or thin section 24 is in a cylindrically shaped recess.

Jones states that sidewall 22 of recess 14 housing thin section 24 can be a shape other than frustoconical depending on the configuration of the fastener used (col. 3, lines 44-49).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a cylindrically shaped recess to accommodate a fastener as taught by Jones.

Regarding claims 5 and 17, Jones discloses that acetabular cups typically include a liner into which the femoral head fits (col. 1, lines 13-23). It is well known that a femoral head is supported by and operably connected to a stem.

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a stem, a femoral head operably connected thereto and a liner positioned between the acetabular cup and the femoral head for replacement of the hip socket as taught by Jones.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Specifically, attention is directed to Pope et al. (US 6,517,583): Figure 2A and col. 10, lines 21-48).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:30 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-2708 for regular communications and (703) 308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

AR

March 9, 2003


PEDRO PHILOGENE
PRIMARY EXAMINER